

(2) The patent owner may file a request for rehearing of the decision of the Board of Patent Appeals and Interferences under § 1.979(a).

(c) Where the patent owner has responded under paragraph (b)(1) of this section, any third party requester, within one month of the date of service of the patent owner response, may once file comments on the response. Such written comments must be limited to the issues raised by the decision of the Board of Patent Appeals and Interferences and the patent owner's response. Any third party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 1.17(b) and (c), respectively, which must accompany the comments or reply.

(d) Following any response by the patent owner under paragraph (b)(1) of this section and any written comments from a third party requester under paragraph (c) of this section, the reexamination proceeding will be remanded to the examiner. The statement of the Board of Patent Appeals and Interferences shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection. The examiner will consider any response under paragraph (b)(1) of this section and any written comments by a third party requester under paragraph (c) of this section and issue a determination that the rejection should be maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the patent owner or any third party requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, any party may file a reply to the comments. No third party requester reply may address the comments of any other third party requester reply. Any third party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is

subject to the appeal and brief fees under § 1.17(b) and (c), respectively, which must accompany the comments or reply.

(f) After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, the reexamination proceeding will be returned to the Board of Patent Appeals and Interferences which shall reconsider the matter and issue a new decision. The new decision will incorporate the earlier decision, except for those portions specifically withdrawn.

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956, when the patent owner is responding under paragraph (b)(1) of this section. The time period set forth in paragraph (b) of this section may not be extended when the patent owner is responding under paragraph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

[65 FR 76777, Dec. 7, 2000, as amended at 68 FR 71008, Dec. 22, 2003]

§ 1.979 Action following decision by the Board of Patent Appeals and Interferences or dismissal of appeal in *inter partes* reexamination.

(a) Parties to the appeal may file a request for rehearing of the decision within one month of the date of:

(1) The original decision of the Board of Patent Appeals and Interferences under § 1.977(a),

(2) The original § 1.977(b) decision under the provisions of § 1.977(b)(2),

(3) The expiration of the time for the patent owner to take action under § 1.977(b)(2), or

(4) The new decision of the Board of Patent Appeals and Interferences under § 1.977(f).

(b) Within one month of the date of service of any request for rehearing under paragraph (a) of this section, or any further request for rehearing under paragraph (c) of this section, any party to the appeal may once file comments in opposition to the request for rehearing or the further request for rehearing. The comments in opposition must be limited to the issues raised in the request for rehearing or the further request for rehearing.

(c) If a party to an appeal files a request for rehearing under paragraph (a) of this section, or a further request for rehearing under this section, the Board of Patent Appeals and Interferences will issue a decision on rehearing. This decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn. If the decision on rehearing becomes, in effect, a new decision, and the Board of Patent Appeals and Interferences so states, then any party to the appeal may, within one month of the new decision, file a further request for rehearing of the new decision under this subsection.

(d) Any request for rehearing shall state the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.

(e) The parties to an appeal to the Board of Patent Appeals and Interferences may not appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983 until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board of Patent Appeals and Interferences is final and appealable by any party to an appeal to the Board of Patent Appeals and Interferences who is dissatisfied with the final decision of the Board of Patent Appeals and Interferences.

(f) An appeal to the Board of Patent Appeals and Interferences by a party is considered terminated by the dismissal of that party's appeal, the failure of the party to timely request rehearing under § 1.979(a) or (c), or the failure of the party to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983. The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the date on which the time for the appeal to the U.S. Court of Appeals for the Federal Circuit expires. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, the appeal is considered terminated when the mandate is issued by the U.S. Court of Appeals for the Federal Circuit. Upon termination of an appeal, if no other appeal is present, the reexam-

ination proceeding will be terminated and the Director will issue a certificate under § 1.997.

(g) The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

[65 FR 76777, Dec. 7, 2000, as amended at 68 FR 71008, Dec. 22, 2003]

§ 1.981 Reopening after decision by the Board of Patent Appeals and Interferences in *inter partes* reexamination.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.977 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN INTER PARTES REEXAMINATION

§ 1.983 Appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.

(a) The patent owner or third party requester in an *inter partes* reexamination proceeding who is a party to an appeal to the Board of Patent Appeals and Interferences and who is dissatisfied with the decision of the Board of Patent Appeals and Interferences may, subject to § 1.979(e), appeal to the U.S. Court of Appeals for the Federal Circuit and may be a party to any appeal thereto taken from a reexamination decision of the Board of Patent Appeals and Interferences.

(b) The appellant must take the following steps in such an appeal:

(1) In the U.S. Patent and Trademark Office, timely file a written notice of appeal directed to the Director in accordance with §§ 1.302 and 1.304;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the U.S. Court of Appeals for the Federal Circuit; and